REMARKS

In the Non-Final Office Action mailed on January 13, 2005 (paper no. 010605), the Examiner rejected claims 1-3, 11, and 32 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,251,010) to Tajiri et al. ("Tajiri") and Japanese Publication No. 10-021066 by Kawamura et al. ("Kawamura"). Applicant respectfully traverses this rejection.

Applicant's technology is useful to those developing and publishing successive versions of a computer program such as a game. In particular, applicant's technology is directed to comparing the source code of two versions of the game to automatically derive a set of state modification rules, that, when applied, automatically transform a game state that is valid for the first version of the game to a game state that is valid for the second version of the game.

At 9:21-48, Tajiri describes rules that transform a first game state into a second game state. For example, given a game whose version 1 does not associate a sex attribute with characters and whose version 2 does associate a sex attribute with characters: when a state produced by version 1 is adapted to be used by version 2, a rule creates and randomly populates a sex attribute for each character present in the state; when a state produced by version 2 is adapted to be used by version 1, another rule deletes the sex attribute from each character. The Examiner has not pointed to, and applicant cannot locate in Tajiri, any indication of how Tajiri's rules are generated. Accordingly, as best applicant can determine, Tajiri's rules are manually generated based upon a manual comparison of the different game versions.

In the passages of Kawamura identified by the Examiner, Kawamura describes applying to version 2 of a program "corrections" that were earlier made to version 1 of the same program. Kawamura describes that the application of these corrections to version 2 is based upon a comparison of the pre-corrected version 1 to each of a corrected version 1 and a pre-corrected version 2.

All of the pending claims recite, in a computing system, comparing the first and second versions of a game to identify dependencies on the state of the second version of the game not shared by the first version of the game or similar language. Neither of the cited references discloses this feature of the claims. In particular, there is no indication that the rules used in Tajiri are generated based upon a comparison in a computer system of two versions of a game, and Kawamura appears to analyze code to determine attributes of the code, rather than identify inconsistency dependencies on the state of a program as recited.

All of the claims further recite automatically generating a rule to modify states used with the first version of the game to satisfy the identified dependency, or similar language. Again, neither of the cited references discloses this claimed feature. To the contrary, (a) there is no indication that Tajiri's rules are automatically generated, and (b) Kawamura appears to disclose nothing regarding rules that modify states used with the first version of a game or other programs to satisfy an identified dependency; rather, the portions of Kawamura cited by the Examiner appear to describe modification of program code, rather than program state, which may or may not be performed in accordance with rules.

Further, this rejection is based solely on the Examiner's assertion that one of ordinary skill in the art would have been motivated to extend the combination of these two references in accordance with applicant's claims because so extending them would produce a beneficial result. This is an inadequate basis for rejection under 35 U.S.C. § 103(a).

According to the manual of patent examining procedure and controlling case law, the combination to combine or extend prior art references cannot be based on mere common knowledge and common sense as to benefits that would result from such combination or modification. Instead, such motivation must be based upon specific teaching in the prior art, such as a specific suggestion in a prior art reference.

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
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> *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art*, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Manual of Patent Examining Procedure, § 2143 (emphasis added).

In contrast to this well-established standard, the motivation to extend this prior art reference provided by the Examiner is based solely on the alleged beneficial results that would be produced by extending it, without identifying any motivation from the prior art that supports the extension as is required. Applicants accordingly request that the Examiner reconsider and withdraw this rejection. If the Examiner elects to maintain this rejection, however, applicants respectfully request that the Examiner explain with the required specificity where a suggestion or motivation to extend the reference in the manner proposed by the Examiner can be found in the prior art.

For the reasons set forth above, applicant submits that all of the pending claims are patentable over Tajiri and Kawamura. Accordingly, applicant earnestly solicits a prompt Notice of Allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 345008002US1 from which the undersigned is authorized to draw.

Dated: July 13, 2005

Respectfully submitted,

By _____

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